

REMARKS

Claims 1 through 29, 98 through 105, and 122 through 127 were presented for examination in the present application. The instant amendment cancels non-elected claims 30 through 97, 106 through 121, and 128 through 147 without prejudice. Thus, claims 1 through 29, 98 through 105, and 122 through 127 are presented for consideration upon entry of the instant amendment which is respectfully requested.

Claims 1 through 29, 98 through 105, and 122 through 127 were rejected under 35 U.S.C. 112, second paragraph. Claims 1 through 29, 98 through 105, and 122 through 127 have been amended to overcome the rejections. Specifically, claims 1 through 29, 98 through 105, and 122 through 127 have been clarified to be directed to a composition. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections to claims 1 through 29, 98 through 105, and 122 through 127 under 35 U.S.C. 112.

In the Office Action dated December 5, 2005, claims 1 through 29, 98 through 105, and 122 through 127 were rejected under 35 U.S.C. 102(b) under the assertion that the claims are anticipated by applicants' own admission. Specifically, the Office Action asserts "Applicant explicitly states on page 1, line 20 of the specification that)-(3-chloro-2-propenyl)hydroxylamine... and its salts are important intermediates for the synthesis of herbicides". See pg. 4, lines 1 – 3. The present Office Action maintains the rejections to these claims for the reasons outlined in the Office Action dated December 5, 2005. Applicants respectfully traverse these rejections.

Applicants respectfully submit that CPHA and its salts are not the present invention. This is clear not only from the invention that is the subject matter of the claims, but also from what is described in detail in the Specification. In fact, much of the Specification is dedicated to describing in detail how the present invention differs from CPHA and its salts.

The Specification discloses, at least, each of the following properties of CPHA:

1. "O-(3- Chloro-2-propenyl)hydroxylamine (CPHA), especially *trans*-isomer, or its salts is an important intermediate for a number of herbicides. This compound has always been prepared in its salt form, especially its hydrochloride (CPHA-HCl) emphasis added". See pg. 1, lines 20 – 24; and

2. CPHA-HCl is commercially available as "40% CPHA-HCL solution". See pg. 1, line 29. "Commercially available 40% CPHA-HCL solutions ... contain about 1000 ppm hydroxylamine". See pg. 2, lines 8 – 9.

The Specification also discloses a number of differences between the CPHA-HCl solution and the O-substituted hydroxylamine free base composition that is the subject of the present invention. For example, the Specification discloses each of the following:

1. Unlike the 40% CPHA-HCl solution, the "free base CPHA produced by the methods described in the present invention ... is essentially free of hydroxylamine. . . . The term "essentially free of" as used herein means that those impurities become non-detectable by gas chromatography". See pg. 5, lines 17 – 22;

2. "Unlike CPHA-HCl product, which requires a refrigerated warehouse and refrigerated transportation, free base CPHA according to the present invention does not need refrigeration unless the storage time is over six months or the ambient temperature continuously exceeds 45°C". See pg. 5, lines 12 – 15;

3. a "99% purity of solvent-free CPHA of the present invention is about 3.3 times as effective as 40% CPHA-HCl solution". See pg. 6, lines 5 – 7; and

4. "the solvent-free CPHA free base according to the present invention can have a concentration of 100% or less, thus one pound of 100% CPHA free base is equivalent to 3.35 pounds of conventional 40% CPHA-HCl salt solution". See pg. 6, lines 17 – 20.

Thus, Applicants respectfully submit that the CPHA disclosed on page 1, line 20 of the Specification is clearly not the "O-substituted hydroxylamine free base composition" that is the subject of the pending claims.

The Office Action states that where the purification of an old product results in a mere change in degree in its properties, the purified form is unpatentable. The Office Action also states that a novel form of an old compound must possess a new utility or a utility of a different type. However, neither of these statements apply to the present application because the CPHA disclosed on page 1, line 20 and the "O-substituted hydroxylamine free base composition" that is the subject of the pending claims **are two different products**.

Furthermore, amended claim 1 recites "An O-substituted hydroxylamine free base composition having the following general formula... wherein said O-substituted hydroxylamine exhibits at least one property selected from the group consisting of: . . . essentially free of hydroxylamine (emphasis added)".

Thus, clearly, the lack of hydroxylamine in claim 1 distinguishes it over the CPHA disclosed on page 1, line 20. Therefore, claim 1 is believed to be in condition for allowance. Claims 2 through 29 and 102 through 105 depend from independent claim 1 and are, therefore, believed to be in condition for allowance for at least the reasons given above for claim 1. Reconsideration and withdrawal of the rejections to claims 1 through 29 and 102 through 105 are respectfully requested.

Amended claim 98 recites "An O-substituted hydroxylamine free base composition having the following general formula: . . . wherein said O-substituted hydroxylamine is essentially free of hydroxylamine (emphasis added)". As stated above, the lack of hydroxylamine in claim 98 distinguishes it over the CPHA disclosed on page 1, line 20. Thus, claim 98 is believed to be in condition for allowance. Reconsideration and withdrawal of the rejection to claim 98 are respectfully requested.

Amended claim 99 recites "An O-substituted hydroxylamine free base composition having the following general formula: . . . wherein said O-substituted hydroxylamine is essentially free of any solvent (emphasis added)".

As stated above, the CPHA disclosed on page 1, line 20 contains hydroxylamine and is commercially available as a 40% CPHA-HCL solution. This clearly indicates the presence of a solvent. Thus, claim 99 is believed to be in condition for allowance. Reconsideration and withdrawal of the rejection to claim 99 are respectfully requested.

Amended claim 100 also recites "'An O-substituted hydroxylamine free base composition..." The lack of hydroxylamine distinguishes claim 100 over the CPHA disclosed in the Specification as discussed previously. Thus, claim 100 is believed to be in condition for allowance. Reconsideration and withdrawal of the rejection to claim 100 are respectfully requested.

Amended claim 101 recites "An O-substituted hydroxylamine free base composition having the following general formula: . . . wherein said O-substituted hydroxylamine has a high strength (as measured by mole of said O-substituted hydroxylamine per gram of sample) of between about 0.5 to 3.3-fold as much as a 40% O-substituted hydroxylamine salt solution, by weight (emphasis added)".

Thus, claim 101 is not only distinguished over the CPHA disclosed in the Specification because of the lack of hydroxylamine, but also because it has a strength that is 0.5 to 3.3-fold as much as a 40% O-substituted hydroxylamine salt solution. As disclosed previously, the CPHA disclosed in the Specification is commercially available as a 40% CPHA-HCL solution. As such, claim 101 is believed to be in condition for allowance. Reconsideration and withdrawal of the rejection to claim 101 are respectfully requested.

Amended claim 122 recites "An O-substituted hydroxylamine salt composition. . . wherein said O-substituted hydroxylamine salt is essentially free of hydroxylamine

(emphasis added)". The lack of hydroxylamine distinguishes claim 122 over the CPHA disclosed in the Specification as discussed previously. Thus, claim 122 is believed to be in condition for allowance. Claims 123 through 127 depend from independent claim 122 and are believed to be in condition for allowance for at least the reasons given above for claim 122. Reconsideration and withdrawal of the rejections to claims 122 through 127 are respectfully requested.

In view of the above, it is respectfully submitted that the present application is in condition for allowance. Such action is solicited.

In the alternative, it is believed that the instant amendment places the present application in better condition for appeal. Specifically, non-elected claims have been cancelled and the claims have been amended to clarify the distinction between "compound" and "composition" the subject of the 35 U.S.C. 112 rejection. Accordingly, entry and consideration of the instant amendment at least for purposes of appeal are respectfully requested.

If for any reason the Examiner feels that consultation with Applicants' attorney would be helpful in the advancement of the prosecution, the Examiner is invited to call the telephone number below.

Respectfully submitted,

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